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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge McKelvey)

ROBERT H. GRUBBS, DONALD W. WARD,
THOMAS J. SEIDERS and STEVEN D. GOLDBERG,

Junior Party
(Application 10/124,745),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party
(Application 09/392,869).

Patent Interference No. 105,374
Technology Center 1600

REDECLARATION - Bd.R. 203(c)

A. Introduction

1. In the ORDER SETTING TIMES FOR TAKING ACTION--
MOTIONS PHASE (Paper 27, Part B(5)), it was indicated that a
formal order redeclaring the interference would be entered during
the first week in January of 2006.

2. This REDECLARATION is intended to be that formal
order.

1 **B. Order**

2 Substitution of Counts 4, 5 and 6 for Counts 1, 2 and 3

3 1. The parties have agreed that Count 4 should be
4 substituted for Count 1 (Paper 1, pages 6-7); the board concurs
5 (Paper 27, page 2, ¶ B(1)).

6 2. The parties have agreed that Count 5 should be
7 substituted for Count 2 (Paper 1, pages 8-9); the board concurs
8 (Paper 27, page 2, ¶ B(1)).

9 3. The parties have agreed that Count 6 should be
10 substituted for Count 3 (Paper 1, pages 10-11); the board concurs
11 (Paper 27, page 2, ¶ B(1)).

12 4. Count 4, which is set out in Appendix 1 of this
13 REDECLARATION is substituted for Count 1 (Paper 1, pages 6-7).

14 5. Count 5, which is set out in Appendix 2 of this
15 REDECLARATION is substituted for Count 2 (Paper 1, pages 8-9).

16 6. Count 6, which is set out in Appendix 3 of this
17 REDECLARATION is substituted for Count 2 (Paper 1, pages 10-11).

18 Claim correspondence
19

20 7. In a MEMORANDUM OPINION and ORDER -- Bd.R. 104(a)
21 (Paper 3), the board (1) invited Nolan to correct Fig. 4 of its
22 drawings and (2) required the parties to submit a new set of
23 claims.

24 8. Because the parties have agreed on a count which
25 the board finds suitable, there is no need for the parties to
26 file an amendment (Paper 29, pages 2-3, ¶¶ 6-9).

1 9. Accordingly, any amendments of the claims
2 submitted by the parties need not be entered.

3 10. Instead, the interference can be resolved on the
4 basis of the Grubbs and Nolan claims presently in the respective
5 applications involved in the interference.

6
7 11. The claims of the parties are:

8 Grubbs: 1-34 and 40-75

9
10 Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and
11 77-111

12
13 12. The claims of the parties which correspond to
14 Count 4 are:

15 Grubbs: 1-15, 17-34 and 40-75

16 Nolan: 9, 11-14, 17-21, 23-40, 45-46, 51-63,
17 65, and 77-78, 89-92 and 107-109

18
19 13. The claims of the parties which do not correspond
20 to Count 4 are:

21 Grubbs: 16

22 Nolan: 43-44, 47-50, 64, 71-73, 79-88, 93-106
23 and 110-111

24
25 14. The claims of the parties which correspond to
26 Count 5 are:

27 Grubbs: 1-9, 11-15, 17-34, 40-48 and 64-74

28 Nolan: 14, 17-21, 23-26, 33-38, 43-44, 47-48,
29 53-58, 60-62, 77-78 and 90-111

1 15. The claims of the parties which do not correspond
2 to Count 5 are:

3 Grubbs: 10, 16, 49-63 and 75

4 Nolan: 9, 11-13, 27-32, 39-40, 45-46, 49-52,
5 59, 63-65, 71-73 and 79-89
6
7

8 16. The claims of the parties which correspond to
9 Count 6 are:

10 Grubbs: 1-9, 11-15, 17-34, 40-48 and 64-74

11 Nolan: 9, 11-14, 17-21, 23-38, 43-44, 49-62,
12 77-78, 90-92 and 107-109
13

14 17. The claims of the parties which do not correspond
15 to Count 6 are:

16 Grubbs: 10, 16, 49-63 and 75

17 Nolan: 39-40, 45-48, 63-65, 71-73, 79-89, 93-
18 106 and 110-111
19
20

21 Priority benefit

22 18. Consistent with discussion during a conference
23 call (Paper 27, page 2, ¶ B(4)), the benefit accorded in the
24 DECLARATION (Paper 1, pages 3 and 4) would be accorded.

25 19. Since no benefit was accorded in the DECLARATION,
26 no benefit is accorded to either party with respect to any of
27 Counts 4, 5 or 6.

28 Nolan request to amend its drawing
29

30 20. Nolan has filed an amendment to correct Fig. 4 of
31 its drawings.

1 21. Entry of the amendment is being authorized in
2 Grubbs v. Nolan, Interference 105,373.

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6 /ss/Fred E. McKelvey
7 FRED E. McKELVEY,
8 Senior Administrative Patent Judge¹
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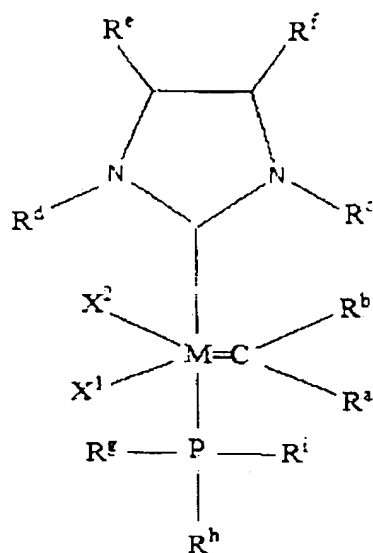
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11 18 January 2006
12 Alexandria, VA

¹ As part of board efforts under the government Paperwork Elimination Act, signatures on papers originating from the board have been phased out in favor of a completely electronic record. Consequently, in this case papers originating at the board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 CFR § 10.18.

Appendix 1

Count 4

A composition of matter have the formula:



where:

M is Ru or Os;

X¹ and X² are each independently an anionic ligand;

P is phosphorus

R^a is:

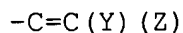
- (1) hydrogen,
- (2) a hydrocarbyl group or
- (3) a hydrocarbyl group substituted with a
 - (a) a C₁₋₁₀ alkyl group,
 - (b) a C₁₋₁₀ alkoxy group,

- 1 (c) halogen or
2
3 (d) a phenyl group substituted with:
4
5 (i) halogen,
6
7 (ii) a C₁₋₅ alkyl group or
8
9 (iii) a C₁₋₅ alkoxy group, and
10
11

12 R^b is:

- 13 (1) hydrogen,
14
15 (2) a carboxy group
16
17 (3) a hydrocarbyl group or
18
19 (4) a hydrocarbyl group substituted with a
20
21 (a) a C₁₋₁₀ alkyl group,
22
23 (b) a C₁₋₁₀ alkoxy group,
24
25 (c) halogen or
26
27 (d) a phenyl group substituted with:
28
29 (i) halogen,
30
31 (ii) a C₁₋₅ alkyl group or
32
33 (iii) a C₁₋₅ alkoxy group,
34
35

36 with the proviso that neither R^a or R^b can be



38 where Y and Z are each independently any moiety;
39

40 R^c and R^d are each independently:
41

- 42 (1) hydrogen,
43
44 (2) a C₂₋₂₀ alkoxy carbonyl group,
45
46 (3) a C₁₋₂₀ carboxylato group,
47
48 (4) a C₁₋₂₀ alkoxy group,
49
50 (5) a C₂₋₂₀ alkenyloxy group,
51
52

- 1 (6) a C₂₋₂₀ alkynyloxy group,
2
3 (7) an aryloxy group,
4
5 (8) a hydrocarbyl group or
6
7 (9) a hydrocarbyl group substituted with
8
9 (a) a C₁₋₁₀ alkyl group,
10
11 (b) a C₁₋₁₀ alkoxy group,
12
13 (c) halogen or
14
15 (d) a phenyl group substituted with
16
17 (i) halogen
18
19 (ii) a C₁₋₅ alkyl group or
20
21 (iii) a C₁₋₅ alkoxy group; and
22

23 R^e and R^f are each independently;
24

- 25 (1) hydrogen,
26
27 (2) a hydrocarbyl group,
28
29 (3) a C₂₋₂₀ alkoxy carbonyl group,
30
31 (4) a C₁₋₂₀ carboxylato group,
32
33 (5) a C₁₋₂₀ alkoxy group,
34
35 (6) a C₂₋₂₀ alkenyloxy group,
36
37 (7) a C₂₋₂₀ alkynyloxy group,
38
39 (8) an aryloxy group,
40

41 where each R^e and R^f is optionally substituted with:
42

- 43 (a) a C₁₋₅ alkyl group,
44
45 (b) a C₁₋₅ alkoxy group,
46
47 (c) halogen or
48
49 (d) a phenyl group substituted with:
50
51
52

1 (i) halogen,

2 (ii) a C₁₋₅ alkyl group or

3 (iii) a C₁₋₅ alkoxy group;

4
5 R^g, R^h and Rⁱ are each independently:

6 (1) a C₁₋₁₀ alkyl group,

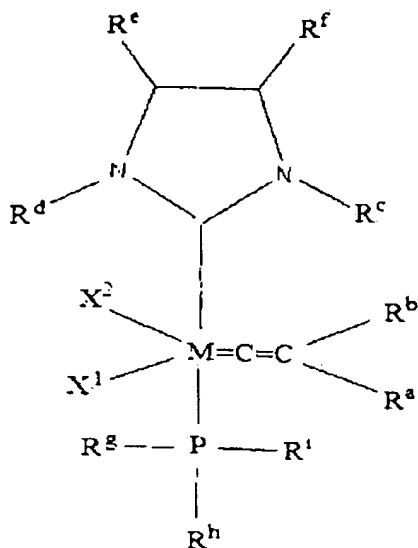
7 (2) a C₃₋₁₀ cycloalkyl group or

8 (3) a C₅₋₂₀ aryl group.

Appendix 2

Count 5

A composition of matter having the formula:



where:

M is Ru or Os;

X^1 and X^2 are each independently an anionic ligand;

P is phosphorus

R^a is:

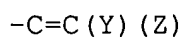
- (1) hydrogen,
- (2) a hydrocarbyl group or
- (3) a hydrocarbyl group substituted with a
 - (a) a C_{1-10} alkyl group,
 - (b) a C_{1-10} alkoxy group,
 - (c) halogen or
 - (d) a phenyl group substituted with:

- (i) halogen,
(ii) a C₁₋₅ alkyl group or
(iii) a C₁₋₅ alkoxy group, and

R^b is:

- (1) hydrogen,
(2) a carboxy group
(3) a hydrocarbyl group or
(4) a hydrocarbyl group substituted with a
(a) a C₁₋₁₀ alkyl group,
(b) a C₁₋₁₀ alkoxy group,
(c) halogen or
(d) a phenyl group substituted with:
(i) halogen,
(ii) a C₁₋₅ alkyl group or
(iii) a C₁₋₅ alkoxy group,

with the proviso that neither R^a or R^b can be



where Y and Z are each independently any moiety;

R^c and R^d are each independently:

- (1) hydrogen,
(2) a C₂₋₂₀ alkoxy carbonyl group,
(3) a C₁₋₂₀ carboxylato group,
(4) a C₁₋₂₀ alkoxy group,
(5) a C₂₋₂₀ alkenyloxy group,
(6) a C₂₋₂₀ alkynyloxy group,
(7) an aryloxy group,

- 1 (8) a hydrocarbyl group or
2
3 (9) a hydrocarbyl group substituted with
4
5 (a) a C₁₋₁₀ alkyl group,
6
7 (b) a C₁₋₁₀ alkoxy group,
8
9 (c) halogen or
10
11 (d) a phenyl group substituted with
12
13 (i) halogen
14
15 (ii) a C₁₋₅ alkyl group or
16
17 (iii) a C₁₋₅ alkoxy group; and
18
19 R^e and R^f are each independently;
20
21 (1) hydrogen,
22
23 (2) a hydrocarbyl group,
24
25 (3) a C₂₋₂₀ alkoxycarbonyl group,
26
27 (4) a C₁₋₂₀ carboxylato group,
28
29 (5) a C₁₋₂₀ alkoxy group,
30
31 (6) a C₂₋₂₀ alkenyloxy group,
32
33 (7) a C₂₋₂₀ alkynyloxy group,
34
35 (8) an aryloxy group,
36
37 where each R^e and R^f is optionally substituted with:
38
39 (a) a C₁₋₅ alkyl group,
40
41 (b) a C₁₋₅ alkoxy group,
42
43 (c) halogen or
44
45 (d) a phenyl group substituted with:
46
47 (i) halogen,
48
49 (ii) a C₁₋₅ alkyl group or
50
51 (iii) a C₁₋₅ alkoxy group;
52

1 R^g , R^h and R^i are each independently:
2

3 (1) a C_{1-10} alkyl group,
4

5 (2) a C_{3-10} cycloalkyl group or
6

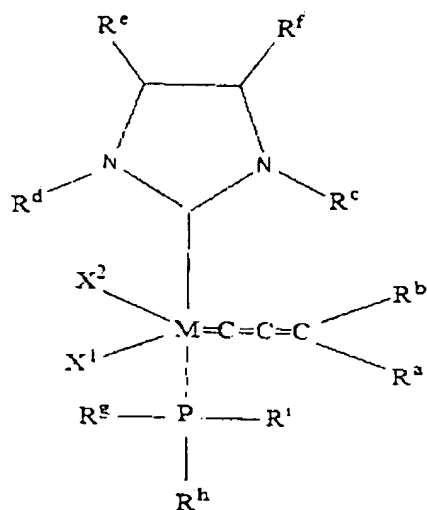
7 (3) a C_{5-20} aryl group.
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Appendix 3

Count 6

A composition of matter having the formula:



where:

M is Ru or Os;

X¹ and X² are each independently an anionic ligand;

P is phosphorus

R^a is:

- (1) hydrogen,
- (2) a hydrocarbyl group or
- (3) a hydrocarbyl group substituted with a
 - (a) a C₁₋₁₀ alkyl group,
 - (b) a C₁₋₁₀ alkoxy group,
 - (c) halogen or

1 (d) a phenyl group substituted with:

2
3 (i) halogen,

4 (ii) a C₁₋₅ alkyl group or

5 (iii) a C₁₋₅ alkoxy group, and

6
7
8
9
10 R^b is:

11 (1) hydrogen,

12 (2) a carboxy group

13 (3) a hydrocarbyl group or

14 (4) a hydrocarbyl group substituted with a

15 (a) a C₁₋₁₀ alkyl group,

16 (b) a C₁₋₁₀ alkoxy group,

17 (c) halogen or

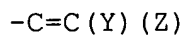
18 (d) a phenyl group substituted with:

19 (i) halogen,

20 (ii) a C₁₋₅ alkyl group or

21 (iii) a C₁₋₅ alkoxy group,

22 with the proviso that neither R^a or R^b can be



24 where Y and Z are each independently any moiety;

25 R^c and R^d are each independently:

26 (1) hydrogen,

27 (2) a C₂₋₂₀ alkoxy carbonyl group,

28 (3) a C₁₋₂₀ carboxylato group,

29 (4) a C₁₋₂₀ alkoxy group,

30 (5) a C₂₋₂₀ alkenyloxy group,

31 (6) a C₂₋₂₀ alkynyloxy group,

- 1 (7) an aryloxy group,
2
3 (8) a hydrocarbyl group or
4
5 (9) a hydrocarbyl group substituted with
6
7 (a) a C₁₋₁₀ alkyl group,
8
9 (b) a C₁₋₁₀ alkoxy group,
10
11 (c) halogen or
12
13 (d) a phenyl group substituted with
14
15 (i) halogen
16
17 (ii) a C₁₋₅ alkyl group or
18
19 (iii) a C₁₋₅ alkoxy group; and
20
21 R^e and R^f are each independently;
22
23 (1) hydrogen,
24
25 (2) a hydrocarbyl group,
26
27 (3) a C₂₋₂₀ alkoxy carbonyl group,
28
29 (4) a C₁₋₂₀ carboxylato group,
30
31 (5) a C₁₋₂₀ alkoxy group,
32
33 (6) a C₂₋₂₀ alkenyloxy group,
34
35 (7) a C₂₋₂₀ alkynyloxy group,
36
37 (8) an aryloxy group,
38
39 where each R^e and R^f is optionally substituted with:
40
41 (a) a C₁₋₅ alkyl group,
42
43 (b) a C₁₋₅ alkoxy group,
44
45 (c) halogen or
46
47 (d) a phenyl group substituted with:
48
49
50
51
52

1 (i) halogen,

2 (ii) a C₁₋₅ alkyl group or

3 (iii) a C₁₋₅ alkoxy group;

4
5 R^g, R^h and Rⁱ are each independently:

6 (1) a C₁₋₁₀ alkyl group,

7 (2) a C₃₋₁₀ cycloalkyl group or

8 (3) a C₅₋₂₀ aryl group.

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